UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,491	12/04/2000	Hua Chen	SOM920000009US1/1963-7398	6533

7590 03/30/2004	EXAMINER
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ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/727,491	CHEN ET AL.
	Examiner	Art Unit
	Cong-Lac Huynh	2178

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 December 2000</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>04 December 2000</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>1 & 4</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: the application filed on 12/04/00,

and the IDS filed on 3/15/01.

2.   Claims 1-20 are pending in the case. Claims 1, 11, 14 are independent claims.

Inventorship

3.   In view of the papers filed 6/26/01, it has been found that this nonprovisional

application, as filed, through error and without deceptive intent, improperly set forth the

inventorship, and accordingly, this application has been corrected in compliance with 37

CFR 1.48(a). The inventorship of this application has been changed by adding the

inventor Qun Zhou into the list of the inventors.

The application will be forwarded to the Office of Initial Patent Examination

(OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and

PTO PALM data to reflect the inventorship as corrected.

Drawings

4.   The drawings are objected to for the following reasons:

-   figure 6 is not legible

-   there is no consistence between the specification (pages 5-6, 8) and the

    drawings (figures 1, 3-5). For example, there is no Rich Media asset 13 in figure

    1, no #502 for Graphical Stand-Alone Authoring Tool in figure 5

Applicants are requested to *check the numbers and the corresponding items* as

disclosed in the specification and *in all of the figures*. Also, it is suggested to change

the black background since it is hard to tell which corresponding item a number points

to.

Specification

5.   It is requested that Applicants update the status of the related application

mentioned in the specification (page 1, line 20).

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

7.   Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Regarding independent claim 1, it is incorrect when combining "*the template* and the

Rich Media Content description file in the processor to create a MVR file executable on

a multimedia player" (lines 6-7) since the Rich Media Content description file means the

template, and the *XML textual specification description*, e.g. the template, *is combined*

with the raw media asset as disclosed in the specification (pages 13-20: "... a creator

using a standard graphical or text editing tool has access to raw media assets on the

disk for *preparing a textual specification description, typically XML in an electronic*

template of desired Rich Media Content. *The template and raw media assets are*

transmitted by the creator to the server for *combining the raw media assets and the*

XML textual specification in the template as a composed file ...").

Independent claims 11, 14, and dependent claims 6-8 are also rejected under the same

issue.

Dependent claims 2-10, 12-13, 15-20 are rejected for fully incorporating the deficiencies

of their base claims 1, 11, and 14.

Double Patenting

8.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*,
418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be
used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent is shown to be commonly
owned with this application. See 37 CFR 1.130(b).
        Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

9.   Claims 1-20 are provisionally rejected under the judicially created doctrine of

double patenting over claims 1-6, 10-13, 18-21, and 27 of copending Application No.

09/727,524. This is a provisional double patenting rejection since the conflicting claims

have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

'524 discloses:

- creating a template for structuring Rich Media Content (claim 1)

- combining the template and the Rich Media content in the processor to create a MVR file executable on a multimedia player (claim 1)

- creating an XML based MVR file using a text editor (claims 2-3)

- operating the processor in a batch mode to combine the template and the Rich Media Content into a Multimedia Vehicle Repository (MVR) file executable on a multimedia player (claim 4)

- injecting content into the template by users (claim 2: editing the Rich Media Content description file by a user suggests injecting data to the template since editing includes adding data)

- managing the creation of the template and Rich Media content file in stages by different users (claim 6)

- the MVR file is a Rich Media container in a binary format (claim 10)

- using an MVR-XML file as a data interchange among other Rich Media Content creation application (claim 5)

'524 does not disclose:

- accessing the Rich Media assets using a processor as an authoring tool to create

  - a Multimedia Vehicle Repository (MVR) file of selected stored Rich Media assets

  in a text based format

However, '524 discloses:

- collecting and formatting Rich Media as a Multimedia Vehicle Repository (MVR)

  file and a first input to an authoring tool (claim 1)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made to have modified '524 to include said accessing above since

collecting and formatting Rich Media Content as a MVR file suggest accessing the

Media asset for collecting media content and creating a MVR file via formatting media

content as a MVR file.

Furthermore, there is no apparent reason why applicant would be prevented from

presenting claims corresponding to those of the instant application in the other

copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA

1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

11.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

12.   Claims 1-2, 6-14, 18-20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Gibbon ((US Pat No. 6,473,778 B1, 10/29/02, filed 2/1/99, priority

12/24/98).

Regarding independent claim 1, Gibbon discloses:

- accessing the Rich Media assets using a processor as an authoring tool to create

  a Multimedia Vehicle Repository (MVR) file of selected stored Rich Media assets

  in a text based format (col 3, lines 18-28, 45-57, col 2, lines 8-12, figure 9 and col

  13, line 53 to col 14, line 7: *accessing a large multimedia database* using

  standard text information retrieval system; using the *automated multimedia*

  authoring tools for creating hypermedia document)

- combining the template and the Rich Media Content description file in the

  processor to create a MRV file executable on a multimedia player (figure 9 and

  col 13, line 53 to col 14, line 7: selecting a template to apply the linked media in

text description file and image description file to the template for rendering a

hypermedia document to users)

Gibbon does not explicitly disclose creating a template for structuring Rich Media

Content. Instead, Gibbon does teach the template set to select for creating a

multimedia document (figure 9 and col 13, line 53 to col 14, line 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have modified Gibbon to include creating a template for structuring Rich

Media Content since *the templates in the template set* for creating a hypermedia

document suggests creating the templates for media content.

Regarding claims 2 and 9, which are dependent on claim 1, Gibbon discloses injecting

other content into the Rich Media content description file (col 5, lines 1-19: placing

anchors elsewhere in the text, modify the list to improve the document layout, …).

Gibbon does not explicitly disclose that the injecting step is performed by another users.

However, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made to have modified Gibbon to include another users to inject media

data to the template for the following reason. Gibbon program provides an authoring

tool to users to generate a multimedia document in response to the user request using a

selected template (col 2, lines 8-12), thus motivating that different users, when using

this program, would insert different media data to a selected template.

Regarding claim 6, which is dependent on claim 1, Gibbon discloses managing the

creation of the template and Rich Media Content description file in stages (figure 9 and

col 13, line 53 to col 14, line 7). Gibbon does not explicitly disclose that said managing

is carried out by different users. However, it would have been obvious to one of

ordinary skill in the art at the time of the invention was made to have modified Gibbon to

include the feature that different users manages the creation of template and media

content file because of the following reason. Gibbon provides templates and media

content files to create hypermedia documents by users (figure 9 and col 13, line 53 to

col 14, line 7; col 2, lines 8-12). This suggests that different users may select a same

template to combine with media content to create a hypermedia document.

Regarding claims 7 and 8, which are dependent on claim 1, Gibbon does not explicitly

disclose operating the processor in a batch mode to combine the template and the Rich

Media content description file into a Multimedia Repository (MVR) file executable on a

multimedia player.

However, Gibbon provides an *automated* method and an *automated multimedia*

authoring tool for creating hypermedia documents from conventional transcription of

television programs wherein a hypermedia document is created by inserting multimedia

content into the template (col 2, lines 46-53, figure 9, and col 13, line 53 to col 14, line

7). Thus, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made to have modified Gibbon to include a batch mode when operating

to combine the template and the media content since the automated feature in Gibbon

suggests that the combining step is performed automatically as in the batch mode

wherein the steps of the program are set up to *run automatically* without user

intervention.

Regarding claim 10, which is dependent on claim 1, Gibbon discloses that the MRV file

is a Rich Media container in a binary format (col 11, lines 63-67: since the video frames

extracted in digital format via the analog-to-digital converter, the multimedia file

including video frames should also be in digital format, that means in the 1s and 0s of

binary numbers).

Claims 11-13 are for a system of method claims 1, 6-7, and are rejected under the

same rationale.

Claims 14, 18-20 are for a program medium of method claims 1-2, 6-8, and are rejected

under the same rationale.

13.   Claims 3-5, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Gibbon as applied to claims 1 and 14 above, and further in view of Hui (US Pat No.

6,654,030 B1, 11/25/03, filed 3/31/99).

Regarding claim 3, which is dependent on claim 1, Gibbon does not disclose creating

an XML based MVR file.

Hui discloses a XML-based video file (figure 1 and col 2, line 59 to col 3, line 30).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Hui into Gibbon since the XML-based video file in Hui

suggests creating a multimedia file in XML-based format, providing the advantage to

apply the XML-based format instead of the HTML-based format to the multimedia file in

Gibbon (figure 9) for enhancing the display of multimedia files on the web such as

synchronizing the video files, a feature that HTML does not provide to multimedia.

Regarding claim 4, which is dependent on claim 1, Gibbon does not disclose using a

textual editor to create an MVR-XML file.

Hui discloses a XML-based video file (figure 1 and col 2, line 59 to col 3, line 30).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Hui into Gibbon since the XML-based multimedia file

would provide the advantage to apply to the HTML-based multimedia file, which is also

in markup language-based for conveying more features for a media file such as video

synchronizing, and it was well known in the art that the multimedia file in XML or HTML

format, which is a text file, is created using any text editor.

Regarding claim 5, which is dependent on claim 1, Gibbon does not disclose using an

MVR-XML file as a data interchange among other Rich Media Content creation

applications.

Hui discloses using an MVR-XML file as a data interchange among other Rich Media

Content creation applications (col 4, lines 49-65 and figure 4: disk 3 has media files for

different applications).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Hui into Gibbon since Hui discloses using an MVR-XML

file as a data interchange among other Rich Media Content creation applications

providing the advantage to replace the MVR-HTML file in Gibbon for advanced features

for video files such as video synchronizing.

Claims 15-17 are a medium of method claims 3-5, and are rejected under the same

rationale.

Conclusion

14.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Matsuzawa et al. (US Pat No. 6,330,004 B1, 12/11/01, filed 11/27/98).

Hsu et al. (US Pat No. 6,295,058 B1, 9/25/01, filed 7/22/98).

Straub et al. (US Pat No. 6,091,411, 7/18/00, filed 12/7/98).

Cedar et al. (US Pat No. 6,256,650 B1, 7/3/01, filed 5/18/98).

Lee et al. (US Pat No. 6,061,696, 5/9/00, filed 4/28/97).

Barrus et al. (US Pat No. 6,693,652 B1, 2/17/04, filed 9/26/00).

Kiyomo et al. (US Pat No. 6,137,483, 10/24/00, filed 11/27/96).

Orr (US Pat No. 6,457,027 B1, 9/24/02, filed 4/1/97).

Balabanovic (US Pat No. 6,624,826 B1, 9/23/03, filed 9/28/99).

Nishi (US Pat No. 6,681,395 B1, 1/20/04, filed 3/18/99).

Livingston et al. (US Pat No. 6,424,979 B1, 7/23/02, filed 12/30/98).

Gibbon, Automated Authoring of Hypermedia Documents of Video Programs, ACM

1995, pages 1-12.

Fraisse et al., Generating Hypermedia from Specification by Sketching Multimedia

Templates, ACM 1996, pages 353-363.

Jourdan et al., Madeus, an Authoring Environment for Interactive Multimedia

Documents, ACM 1998, pages 267-272.

15.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-

0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Clh
3/18/04

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER